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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,663	11/17/2000	Nathalie Garnier	05725.0810-00000	4399

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 11/01/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,663

Applicant(s)

GARNIER ET AL.

Examiner

Sabiha Naim Qazi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 11-100 is/are pending in the application.
- 4a) Of the above claim(s) 43-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 11-42 and 100 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 43-99 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claims 11-100 are pending in this application.

Non elected invention is not canceled. Applicants' claims are drawn to N-substituted formamidinesulphinic acid derivatives compositions useful for permanent deformation of hair. One compound imino(phenylamino)methanesulphinic acid (amended claim 100) has been claimed. Since the claims 11-19 are drafted as compound claims and are drawn to composition claims, they will be examined as compound claims because claims have no carrier.

In response to the office action Applicant has canceled the compounds of claim 100 and amended the claim by inserting a new compound. Since the compound is not deleted and claim is amended, rejection under 102 (b) over Yarovenko et al. is maintained. On Applicant's request Examiner will include claims 11-42 with claim 100 for examination. Claims 43 and 44 are different from original presentation of claim 1, therefore, was not examined.

Claim Rejections - 35 USC § 112

Claims 11-20, 25-36 and 100 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. It is unclear what is the meaning of the citation of "chosen from" in claim 100 when there is only one compound in this claim.
2. In claim 14 compounds 5 and 7 are same. One should be deleted.
3. Citation of "other than said" in claim 20.
4. It is unclear what is intended by "optionally chosen from aromatic rings, and optionally comprising ----- oxygen and sulphur" in claim 11.

Claim Rejections - 35 USC § 102

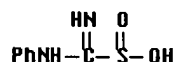
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 100 stand rejected under 35 U.S.C. 102(b) as being anticipated by Yarovenko et al. (DN 73:34993, CAPLUS, abstract of Zh. Org. Khim. (1970), 6(5), 947-9). Claim is not amended to overcome the rejection.



See RN 14451-43-5 which is imino(phenylamino) methane sulphinic acid. Same compound is the elected species and claimed in claim 100.

A. imino(phenylamino) methane sulphinic acid.

RN 14451-43-5 REGISTRY

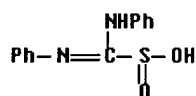
CN Methanesulfinic acid, imino(phenylamino)-

CN Methanesulfinic acid, anilinoimino-.

2. Claim 11, 12, 16-19 and 39-41 rejected under 35 U.S.C. 102(b) as being anticipated by Yarovenko et al. (DN 73:34993, CAPLUS, abstract of Zh. Org. Khim. (1970), 6(5), 947-9).

A. 14451-44-6 REGISTRY

CN Methanesulfinic acid, (phenylamino)(phenylimino)- (9CI) (CA INDEX NAME)

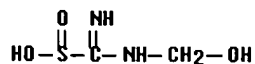


B. N 27395-34-2 REGISTRY

CN Methanesulfinic acid, [(hydroxymethyl)amino]imino- (8CI, 9CI) (CA INDEX NAME)

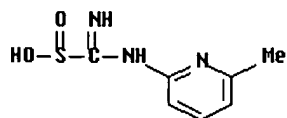
MF C2 H6 N2 O3 S

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2. Claims 11-19, 39-41 rejected under 35 U.S.C. 102(b) as being anticipated by Shibano et al. (DN 70:87599, CAPLUS, abstract of SU 229521). See the following compounds.

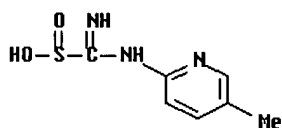
A. RN 22462-66-4



B. RN 22462-65-3

RN 22462-65-3 REGISTRY

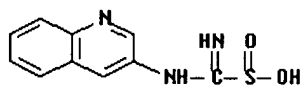
CN Methanesulfinic acid, imino[(5-methyl-2-pyridyl)amino]-, monoammonium salt



C. 22462-67-5 REGISTRY

CN Methanesulfinic acid, imino(3-quinolylamino)-, monoammonium salt (CA INDEX NAME)

MF C10 H9 N3 O2 S . H3 N

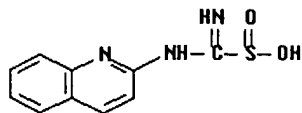


D. 2462-68-6 REGISTRY

CN Methanesulfinic acid, imino(2-quinolylamino)-, monoammonium salt (CA INDEX NAME)

MF C10 H9 N3 O2 S . H3 N

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● NH₃

3. Claim 11, 12, 16-19 and 39-41 rejected under 35 U.S.C. 102(b) as being anticipated by Rao et al. (US Patent 3,051,626). See the entire document especially compounds of examples VI in col. 4 and 5. The compounds and their inorganic or organic salt as instantly claimed are disclosed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

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examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-12, 16-42 and 100 rejected under 35 U.S.C. 103(a) as being unpatentable over Amon, Robert (GB 1,201,601). See the entire document especially lines 1-26 on page 2; lines 39-91, claims and examples I, II and III in GB '601.

The reference cited above teach a hair composition which embraces Applicants's claimed invention. GB '601 teaches a reducing composition for hair waving or straightening containing aminoiminomethanesulfinic acid or a water-soluble salt thereof with other ingredients and pH ranging from 5-8.

Instant claims differ from the reference in different generic scope. Instant claims are broader than the prior art.

It would have been obvious at the time of invention to prepare additional beneficial reducing compositions for the deformation of hair in waving or other operations comprising aminoiminosulphinic acid as disclosed by the prior art. All the conventional ingredients are taught by the prior art including an active agent. The motivation to prepare reducing composition for deformation of hair was provided by the prior art.

Even if the references cited above (in 102 rejections) does not teach use for permanent deformation of hair by at least one compound of formula (1) in claim 11, the two different intended uses are not distinguishable in terms of the composition, see *In re Thuau*, 57 USPQ 324; *Ex parte Douros*, 163 USPQ 667; and *In re Craige*, 89 USPQ 393.

Non-elected invention of claims 43-99 has not been canceled. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Naim Qazi whose telephone number is 703-305-3910. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

October 31, 2002



SABIHA QAZI, PH.D
PRIMARY EXAMINER